



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/850,091	05/08/2001	Etsuko Matsunaga	206445US0CONT	1424

22850 7590 09/25/2002

OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT PC
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

EXAMINER

IBRAHIM, MEDINA AHMED

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 09/25/2002

h

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/850,091

Applicant(s)

MATSUNAGA ET AL.

Examiner

Medina Ibrahim

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 9/354,305.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1638

DETAILED ACTION

Claims 1-26 are pending and are under examination.

Sequence Listing

No CRF and paper sequence listing have been filed with this application. However, page 27, lines 15-16 of the specification recites sequences without sequence identifier. Applicant must submit a CRF and paper copy of the Sequence Listing as required in 37 CFR 1.821-1.825. Applicant must also amend the specification to include the SEQ ID NO for these sequences.

Information Disclosure Statement

Initialed and dated copies of Applicant's IDS form 1449, Paper Nos. 2 and 4 are attached to the instant Office action.

Drawings

The drawings filed with this application have been approved.

Priority

1. Acknowledgment is made of applicants' claim for foreign priority under 35 U.S.C. 119 (a)-(d). The certified copy has been filed in parent Application No. 09/354, 305, filed on 07/16/1999. It is noted, however, that the specific reference to the parent application as required by 35 U.S.C. 120 is missing. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. If

Art Unit: 1638

a parent application has become a patent, the expression "now Patent No. _____" should follow the filing date of the parent application.

Double Patenting

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1638

Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6, 294, 714 in view of Chua et al (US 6, 063, 985, filed January 1998). The claims in the instant application and the claims in the '714 patent are both drawn toward a method for introducing a vector comprising a desired gene, an adventitious shoot redifferentiation gene as a selectable marker gene under the control of a light inducible promoter, a removable DNA element derived from a site-specific recombination system, wherein the selectable marker gene is positioned to behave integrally with the removable DNA element, but not with the desired gene, transgenic plant or plant cell produced by such method. While the method claimed in the patent uses the adventitious shoot redifferentiation gene of ipt as a selectable marker gene and the instantly claimed method uses the adventitious shoot redifferentiation gene of CKI1, it would have been obvious to one of ordinary skill in the art to substitute an ipt gene with a CKI1 gene, given the teachings of Chua et al. Chua et al teach a plant transformation method that uses ipt and CKI1 genes as selectable markers and in the same manner (see at least column 2, line 25, column 3, line 26, and column 14). Therefore, the subject matter instantly claimed, a method for introducing a vector comprising an adventitious shoot redifferentiation gene, including a CKI1 gene, as a selectable marker, under the control of light-induced promoter, and a removable DNA element derived from site-specific recombination system, positioned to behave integrally with

Art Unit: 1638

the CKI1 gene and not with the desired gene and transformed plants/plant cells produced by said method, would have been obvious over the method for introducing a vector comprising an adventitious shoot redifferentiation gene, including an ipt gene, as a selectable marker, under the control of light-induced promoter, and a removable DNA element derived from site-specific recombination system, positioned to behave integrally with the ipt gene and not with the desired gene and transformed plants/plant cells produced by said method, claimed in the patent '714.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6-9 and 11-25 are rejected under 35 U.S.C. 102(b) as being anticipated by SUGITA et al (WO97/42334). Applicants note that the Abstract and figures are relied upon, since the publication is not in english language.

Sugita et al teach a method for transferring a desired gene into a plant comprising introducing a vector comprising the desired gene, an ipt gene as a selectable marker operably linked to a ribulose 2-phosphate carboxylase small subunit, a removable DNA factor located in a position so that it acts together with the selectable but not with the desired, wherein the selectable marker gene is optionally removable.

Art Unit: 1638

(see Abstract; Figures 2-15). Plants and plant cells transformed with said vector have also been disclosed by the reference. Therefore, all claim limitations are anticipated.

Remarks

No claim is allowed.

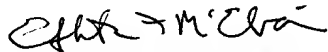
Papers relating to this application may be submitted to Technology Sector 1 by facsimile transmission. Papers should be faxed to Crystal Mall 1, Art Unit 1638, using fax number (703) 308-4242. All Technology Sector 1 fax machines are available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina a. Ibrahim whose telephone number is (703) 306-5822. The Examiner can normally be reached Monday -Tuesday from 8:00AM to 4:00PM and Wednesday-Thursday from 9:00AM to 3:00 PM .

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

September 22, 2002
mai


ELIZABETH F. McELWAIN
PRIMARY EXAMINER
GROUP 1800